

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 22-29 and 31-34 are amended, claims 35-39 are canceled, and new claims 42-45 are added. Claims 1-34 and 40-45 are now pending in the application.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **II. Claim Rejections under 35 U.S.C. § 102**

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure ("MPEP") § 2131.*

**a. Rejections Based on *Kunio***

The Examiner has rejected claims 1-9, 13-17, 19-22, 28, 29, 30, 34, 35, 38, 40, and 41 under 35 U.S.C. § 102(b) as being anticipated by the title and abstract of JP63089925 to Uehara, Kunio ("*Kunio*"). Inasmuch as claims 35 and 38 have been canceled herein, Applicant respectfully submits that the rejection of claims 35 and 38 has been rendered moot and should be withdrawn.

With respect to claims 1-9, 13-17, 19-22, 28, 29, 30, 34, 40, and 41, Applicant notes that the Examiner's reliance on *Kunio* in the rejection of these claims is improper. Specifically, although the Examiner has provided an English translation of the title and abstract of *Kunio*, the Examiner has failed to provide a full-text English translation of the underlying document. As stated in MPEP § 706.02(II), "Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)... If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection... When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action." (*Emphasis added*).

Pursuant to MPEP 706.02(II), therefore, the final rejection of claims 1-9, 13-17, 19-22, 28, 29, 30, 34, 40, and 41 based upon *Kunio* is improper. Applicant therefore respectfully requests that the finality of the rejection of these claims be withdrawn. Applicant further respectfully requests that a complete English translation of *Kunio* be provided in the event that the Examiner wishes to maintain this rejection in a future office action.

**b. Rejections Based on *Kerschner***

The Examiner has also rejected claims 22, 23, 26, 27, 35, 36, and 39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,639,203 to Kerschner ("*Kerschner*"). Inasmuch as claims 35, 36, and 39 have been canceled herein, Applicant respectfully submits that the rejection of claims 35, 36, and 39 has been rendered moot and should be withdrawn.

With regard to claims 22, 23, 26, and 27, Applicant respectfully disagrees but submits that in light of the amendments to these claims made herein, the rejection of these claims should be withdrawn.

By this paper, Applicant has amended independent claim 22 to recite, among other things, "A lens comprising: an input surface comprising: an input transmissive part ... and an input reflective part for reflecting a portion of the incident light beam to a first external device ... and an output surface comprising: an output transmissive part for passing a portion of a refracted light beam; and an output reflective part for reflecting a portion of the refracted light beam to a second external device ..." (*Emphasis added*). Support for these amendments to claim 22 can be found, for example, at least at page 8, lines 14-21 of the application.

In contrast, the Examiner has not established that *Kerschner*, either alone or in combination with any other reference, teaches or suggests the aforementioned limitations in combination with the other limitations of claim 22.

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Kerschner* anticipates claim 22, at least because the Examiner has not established that each and every element as set forth in claim 22 is found in *Kerschner*, because the Examiner has not established that the identical invention is shown in *Kerschner* in as complete detail as is contained in amended claim 22, and because the Examiner has not shown that *Kerschner* discloses the elements of claim 22 arranged as required by claim 22.

Applicant thus respectfully submits that the rejection of claim 22, as well as the rejection of corresponding dependent claims 23, 26, and 27, should be withdrawn.

### **III. Rejection of Claims Under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 10-12 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Kunio*. The Examiner has also rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Kunio* in view of U.S. Patent no 5,343,487 to Scott et al. ("*Scott*"). Applicant respectfully disagrees.

Inasmuch as claims 31-33 depend from amended claim 22, Applicant respectfully submits that claims 31-33 are allowable for at least the reasons set forth herein in connection with the discussion of claim 22, and the rejection of those claims should accordingly be withdrawn.

With regard to claims 10-12 and 18, and to claims 31-33 as well, Applicant notes that the Examiner's reliance on *Kunio* in the final rejection of these claims is improper, as explained at **II.a.** herein. Applicant therefore respectfully requests that the finality of the rejection of these claims be withdrawn and that an English translation of *Kunio* be provided in the event that the Examiner wishes to maintain this rejection in a future office action.

**IV. New Claims**

Applicant notes that new claims 42-45 have been added herein. Support for these new claims can be found, for example, at least at page 8, lines 14-21 of the application. Applicant respectfully submits that these claims are in allowable condition by virtue of their dependence from claim 41.

**V. Docket Number Correction Required**

Applicant respectfully notes that the Office Action incorrectly references Attorney Docket No. "H0005285(1139.1156101)." Pursuant to the Change of Attorney Docket Number filed in this case on November 10, 2004, the correct docket number for this case is 15436.442.14. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 15436.442.14.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-34 and 40-45 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 8th day of November, 2006.

Respectfully submitted,

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